

**REMARKS**

These remarks are directed to the office action mailed December 21, 2007, setting a three month shortened statutory period for response which expired on March 21, 2008. A two month extension request and required fee authorization accompanies this amendment to reset the period so as to expire on May 21, 2008. The office action issued by the examiner and the citations referred to in the office action have been carefully considered.

Claims 1 to 12 were originally filed in this application. In response to an election/restriction requirement, claims 1-5 were elected for examination. In this response, claims 1 and 5 have been amended and claim 3 has been cancelled. Consequently, claims 1-2 and 4-5 remain under consideration. Support for the amendments to claims 1 and 5 can be found in the claims, at page 3, lines 32-35 of the specification and in the drawings, particularly Fig. 2 of the drawings. Therefore, no new matter has been added. Amendment of the claim is not to be construed as an indication to the public of any subject matter.

**Claim rejections - 35 U.S.C. §102**

Claims 1-2 and 5 have been rejected under 35 USC 102(b) as being anticipated by variously, Japanese Patent Publication No. 11-022474A to Osako et al., US Patent No. 4,187,678 to Herenius, US Patent No. 2,866,617 to Land, US Patent No. 4,068,612 to Meiners, Brazilian Patent Publication No. BR 8700406 to Dufour or International Patent Publication No. WO95/33918A1 to Glagolev.

No art has been cited against either claim 3 or 4 of the claims prior to submission of this response.

The features of claim 3 have been included in claims 1 and 5. It is therefore respectfully submitted that the novelty rejection in respect of this application has been overcome and withdrawal of the rejection is courteously solicited.

**Claim rejections 35 U.S.C. § 103**

Claim 3 has been rejected under 35 USC 103(a) as being unpatentable over US Patent No. 4,068,612 to Meiners in view of 5,303,253 to Henning et al.

Claim 4 has been rejected under 35 USC 103(a) as being unpatentable over Meiners in view of US Patent No. 5,857,332 to Johnston et al.

With respect to the rejection of claim 3, as indicated above, the features of claim 3 have been included in claims 1 and 5. Claims 1 and 5 have further both been amended to specify that the jacket surrounds *a periphery and at least one side face of* the housing and, further, that the jacket is arranged in spaced relationship relative to an outer surface of *the periphery and the at least one side face of* the housing.

The Examiner concedes that Meiners fails to disclose the compressor housing for the turbocharger having a jacket. However, the Examiner contends that Henning teaches that it is conventional in the compact flow gas laser art to utilise a compressor housing having a jacket and the Examiner refers the applicant to reference numeral 32 of Figure 3 of Henning.

The Examiner concludes that it would have been obvious to one having ordinary skill in the art at the time the invention was made to have utilised the compressor housing having a jacket as taught by Henning to improve the efficiency of the Meiners device since the use thereof would have cooled down a compressor housing and airflow before being delivered into the engine.

Firstly, it is respectfully pointed out that neither Meiners nor Henning, whether singularly or in combination, discloses all the features of the invention as claimed. It is well established that, in order to establish *prima facie* obviousness of a claimed invention **all** the claim limitations must be taught or suggested by the prior art. (*In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)).

Secondly, Henning deals with non-analogous art. Henning deals with gas lasers, more particularly, carbon dioxide lasers. Carbon dioxide lasers are a totally different art from the field

of turbochargers for internal combustion engines. It is not reasonable to assert that one of ordinary skill in the art of vehicle turbochargers would turn to the non-analogous art of gas lasers in order to overcome the problems with Meiners and to combine Meiners with the structurally and functionally different art of Henning in order to arrive at the invention as presently claimed. The Examiner is respectfully referred to the following cases which deal with issues of non-analogous art and also to MPEP paragraph 2141.01(a) for a discussion of analogous and non-analogous arts:

*In re Clay*, 966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992) (“[The reference] cannot be considered to be within [the inventor's] field of endeavor merely because both relate to the petroleum industry. [The reference] teaches the use of a gel in unconfined and irregular volumes within generally underground natural oilbearing formations to channel flow in a desired direction; [the inventor] teaches the introduction of gel to the confined dead volume of a man-made storage tank. The [reference] process operates in extreme conditions, with petroleum formation temperatures as high as 115 degrees C and at significant well bore pressures; [the inventor's] process apparently operates at ambient temperature and atmospheric pressure. [The inventor's] field of endeavor is the storage of refined liquid hydrocarbons. The field of endeavor of [the reference] invention, on the other hand, is the extraction of crude petroleum.”);

*In re Boyer*, 54 C.C.P.A. 1287 (CCPA 1967) (“Faced with this problem, the totality of the deficiencies in the prior art, the inquiry is whether one of ordinary skill in the edible protein art would turn to the protein paper coating art or more broadly to the industrial protein art to solve these problems. The Patent Office answers, in effect, "Yes," and this for the sole reason that one aspect of the problem solved by appellants is to achieve a lighter color of the protein and Smith allegedly does this. I do not agree with this reasoning. It makes obvious by hindsight what had eluded the workers in the art prior to appellants' invention.”); and

*In re Pagliaro*, 657 F.2d 1219 (CCPA 1981) (“Both the instant claims and Nutting involve decaffeination of vegetable materials; whereas, Aiello compares the solubility of a diuretic solution, such as a caffeine solution combined with an oil/serum mixture, to the same solution combined with an oil/water mixture...Thus, Aiello's disclosure is not ‘within the field of

the inventor's endeavor.' Further, Aeillo is not pertinent to appellants' problem because he is not concerned with either beverage preparation or decaffeination of vegetable materials. There is no common environment which could form a 'close relationship' between either the claimed invention or Nutting on the one hand and Aeillo on the other to logically require consideration of Aeillo.").

The gas laser of Henning is not an analogous art with the field of vehicle turbochargers to which the applicants' claims are directed. Gas lasers are of no relevance in the filed of turbochargers and would not be referenced by a person of ordinary skill in the art of turbochargers.

Furthermore, the problems addressed by the applicants' invention as claimed, i.e., the ability to use a compression ignition engine in hostile environments, is not related to, or even overlapping with, the problem of producing a more efficient or compact gas laser.

Still further, it is respectfully submitted that the Examiner has erred in alleging that Henning teaches that it is conventional in the compact flow gas laser art to utilise the compressor housing having a jacket.

While the laser of Henning is a single casing housing the turbine, the intermediate heat exchanger, the compressor and a second heat exchanger, the water cooled aspect of the jacket referenced by reference numeral 32 of Henning is provided, not for the compressor as indicated by the Examiner, but for the heat exchanger 14. Hence, as discussed at column 7, lines 59 to column 8, line 2, the pipes 31 of the heat exchanger 14 of Henning which convey liquid coolant communicate with the channel 32 of the casing 19. Thus, the channel 32 to which the Examiner has referred is, as will be clear from the cited passage and from Fig. 3 of the drawings of Henning, associated with the heat exchanger 14 of the housing 19 of Henning's gas laser. It is **not** associated with the compressor stage 15 of the gas laser of Henning.

Henning therefore does not teach the use of liquid cooling for the compressor of the gas laser.

It is therefore respectfully submitted that the claims have been rejected using an improper combination of references by the Examiner. *KSR International v Teleflex Inc.* 127S. Ct. 1727, 82U.S.P.Q.2d 1385 (2007) provides guidance with respect to the combination of references used to reject claims of a patent application on the grounds of obviousness. According to the decision in *KSR*: "Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to the established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does (*at 1741*). More importantly "a patent composed of several elements **is not proved obvious by merely demonstrating that each of its elements was, independently known in the prior art**". *Id* (*emphasis added*).

Thus, in *KSR*, the Supreme Court addressed such logic in obviousness type rejections. *KSR* specifically forbids obviousness rejections simply because each element was independently known in the prior art. The art cited against the instant application falls into this category because it is nothing more than two unrelated references showing each of the claimed elements with, with respect, tenuous logic to support the combination.

It is respectfully submitted that, for the reasons set forth above, the Examiner has failed in his burden to explain any compelling reasons why a person of ordinary skill in the art would have combined these references. Moreover, for the reason given above that the cooling of Henning is associated with the heat exchanger, not the compressor, it is respectfully submitted that there is absolutely no motivation for a person of ordinary skill in the art, even assuming that such a person would look at the field of gas lasers (which is denied), would have a reasonable prospect of success of combining the art in order to arrive at the invention as presently claimed.

It is therefore respectfully submitted that the invention as presently claimed in claims 1 and 5 is patentably distinguishable over the art relied on by the Examiner and withdrawal of the rejection is requested.

Further, as claim 1 is allowable, it is respectfully submitted that claims 2 and 4 are similarly allowable. (*In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), "if an

independent claim is non-obvious under 35 U.S.C. §103, then any claim depending therefrom is non-obvious").

**Conclusion**


Applicant has fully responded to each matter of substance raised in the Office Action and believes that the case is in condition for allowance. Withdrawal of the rejections and allowance of the application is therefore courteously solicited. Should the Examiner have any requests, questions or suggestions, the Examiner is invited to contact Applicant's attorney at the number listed below.

Should matters remain which the Examiner believes could be resolved in a telephone interview, the Examiner is requested to telephone the Applicants' undersigned attorney at the phone number below.

The Director is authorized to charge any additional fee(s) or any underpayment of fee(s), or to credit any overpayments to **Deposit Account Number 50-2638**. Please ensure that Attorney Docket Number 058157-014500 is referred to when charging any payments or credits for this case.

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Respectfully submitted,

  
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